

REMARKS

I. PRELIMINARY REMARKS

Claims 1, 8, 10, 12, 13 and 14 have been amended. Non-elected claims 28-42 have been canceled. Claims 43-51 have been added. Claims 1-27 and 43-51 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant notes with appreciation that claims 15-27 have been allowed and that the Examiner has indicated that claims 8-11, 13 and 14 would be allowable if rewritten in independent form. As claims 8, 10, 13 and 14 have been rewritten in independent form, applicant respectfully submits that claims 8-11, 13 and 14 are in condition for allowance.

II. PRIOR ART REJECTIONS

A. The Rejections

Claims 1, 4-7 and 12 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,071,281 to Burnside ("the Burnside patent"). Claims 1, 4, 5, 7 and 12 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,630,426 to Eggers ("the Eggers patent"). Claims 2 and 3 have been rejected under 35 U.S.C. § 103 as being unpatentable the Eggers patent. The rejections under 35 U.S.C. §§ 102 and 103 are respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

B. The Claimed Combinations

Independent claim 1 is directed to "an internal indifferent electrode device for use with a power supply apparatus including a power output connector and a power return

connector.” The internal indifferent electrode device comprises “a flexible shaft,” “at least one energy transmission device” and “an indifferent electrode connector operably connected to the at least one energy transmission device such that **current which passes through the at least one energy transmission device passes through the indifferent electrode connector**, and adapted to mate with the power return connector **without mating with the power output connector**.” The combinations defined by dependent claims 2-7 include, *inter alia*, the elements recited in independent claim 1.

Independent claim 12 is directed to “an internal indifferent electrode device for use with a power supply apparatus including a power output connector defining a first configuration and a power return connector defining a second configuration different than the first configuration.” The internal indifferent electrode device comprises “a flexible shaft,” “a plurality of electrodes” and “an indifferent electrode connector operably connected to the plurality of electrodes such that **current which passes through the plurality of electrodes passes through the indifferent electrode connector**, defining a configuration that substantially corresponds to the second configuration and adapted to mate with the power return connector **without mating with the power output connector**.”

C. Discussion Concerning The Burnside Patent

Referring to Figure 71H of the Burnside patent, the system illustrated therein includes a surgical probe 308 with electrodes 294 (see Figure 71A for reference numeral 294) and a remote power control unit 325 that may be used in conjunction with the surgical probe. The surgical probe 308 is connected to a power supply and control apparatus unit by a connector (not numbered), while the remote power control unit 325 is connected to the power supply and control apparatus by a separate connector 329b.

Despite disclosing a wide variety of surgical systems, the Burnside patent fails to teach or suggest the claimed combinations. For example, the Office Action appears to have taken the position that the electrodes 294 correspond to the claimed “energy transmission device” recited in independent claim 1 and the “electrodes” recited in

independent claim 12, and that the remote power control unit connector 329b corresponds to the respective "internal indifferent electrode connector[s]" recited in independent claims 1 and 12. In contrast to the claimed combinations, however, current which passes through the electrodes 294 does not pass through the connector 329b. Instead, signals from the remote power control unit 325 pass through the connector 329b.

As the Burnside patent fails to teach or suggest each and every element of the respective combinations recited in independent claims 1 and 12, applicant respectfully submits that claims 1, 4-7 and 12 are patentable thereover and that the rejection thereof under 35 U.S.C. § 102 should be withdrawn.

D. Discussion Concerning The Eggers Patent

The Eggers patent also fails to teach or suggest the claimed combinations of elements. For example, referring to Figures 1 and 2, the Eggers patent discloses an apparatus 10 including a probe 20 that is connected by a cable 30 to a controller 40. The controller 40 includes a power port 41, through which power is both transmitted and received, and the cable 30 includes a corresponding connector 31. Accordingly, even assuming for the sake of argument that the power port 41 is both a "power output connector" and a "power return connector," the Eggers connector 31 cannot "mate with the power return connector *without mating with the power output connector*," as called for in the respective combinations defined by independent claims 1 and 12.

As the Eggers patent fails to teach or suggest each and every element of the respective combinations recited in independent claims 1 and 12, applicant respectfully submits that claims 1, 2-5, 7 and 12 are patentable thereover and that the rejections thereof under 35 U.S.C. §§ 102 and 103 should be withdrawn.

III. NEWLY PRESENTED CLAIMS 43-51

Newly presented claims 43 and 44 depend from independent claim 8 and are patentable for at least the same reasons as claim 8.

Newly presented claim 45 depends from independent claim 10 and is patentable for at least the same reasons as claim 10.

Newly presented claim 46 is directed to "an internal indifferent electrode device for use with a power supply apparatus including a power output connector and a power return connector." The internal indifferent electrode device comprises "a flexible shaft defining a distal end, a distal portion, a proximal end and a proximal portion," "at least one energy transmission device adapted to be inserted into a body supported on the distal portion of the flexible shaft" and "means for connecting the at least one energy transmission device to the power return connector and preventing the at least one energy transmission device from being connected to the power output connector." Applicant respectfully submits that the cited references fail to teach or suggest such a combination and that claims 46-51 are patentable thereover.

IV. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

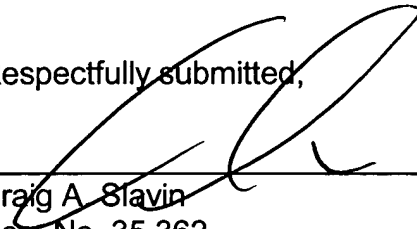
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such

fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

3/31/04
Date

Henricks, Slavin & Holmes LLP
840 Apollo Street, Suite 200
El Segundo, CA 90245
(310) 563-1458
(310) 563-1460 (Facsimile)

Respectfully submitted,


Craig A. Slavin
Reg. No. 35,362
Attorney for Applicant